



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No.: ATM-2129-1

CP 1773

#119

Applicant : Roman FUCHS et al.

Serial No. : 09/898,167

Group Art Unit: 1773

Filed : July 5, 2001

Title : REFLECTOR WITH RESISTANT SURFACE

COPY OF PAPERS
ORIGINALLY FILED

PRELIMINARY AMENDMENT

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This reissue application seeks to reissue U.S. Patent No. 5,919,561 to correct an error which resulted in the translation into English of the German language priority Swiss patent application. The translator erroneously did not translate the German word "von" so the English translation comprising the U.S. application underlying U.S. Patent No. 5,919,561 left out the English word "from". The details are set out in the reissue application declaration and the declaration of the translator, both of record.

While 37 C.F.R. 1.121(b)(5)(B) says that no amendment to a patent sought to be reissued may introduce new matter, however the amendment to the present patent is believed to not be new matter.

The mistranslation sought to be corrected does not involve any claim or claim limitation or any preferred range. The error was that the translator left the word "from" out of the phrase "are typically from 1 nm thick, preferably from 40 to 200 nm thick" (in German). One skilled in the art would know that an error was present in the phrase "are typically 1 nm thick, preferably from 40 to 200 nm thick." That is, it appears to be an error to say that the (each) transparent protective layer typically has a thickness of 1 nm when

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the preferred thickness range is from 40 to 200 nm. Note that Claim 12 does not contain any thickness value or range for any of the transparent protective layers of reflective layer (c).

In the case of *In re Oda et al.*, 170 USPQ 268, (C.C.P.A. 1971), mistranslations were made in preparing the U.S. application in English from corresponding Japanese applications. The patentees in such instance filed a reissue application to correct the U.S. patent. The C.C.P.A. ruled that correction of such mistranslations was not "new matter" and allowed the compound claims of the reissue application.

The C.C.P.A. stated that:

"Running through the foregoing discussion of the law is the clear and basic concept that *the invention* described in the original patent must not be changed. We note first of all that that is not a problem in this case. The invention before us, as defined in the claims, consists of three specific chemical compounds. There is no change proposed in the claims or in the description of the claimed compounds in the specification. There is no deviation whatever with respect to the invention."

[Emphasis supplied] [Page 271]

The Court also stated:

"Once the translator decided incorrectly, that what the Japanese application said was 'nitrous' it was only reasonable that he should be consistent; we are considering a translation error, not a typographical error." [Emphasis supplied]

[Page 272]

"We also think there is adequate evidence in the record to show that the error in saying 'nitrous' instead of 'nitric' was a translation error. The reissue oath, made by all four inventors, so states. A separate affidavit of Hiroshu Fujii, one of the

inventors, familiar with the U.S. application and the corresponding Japanese application, states that in the Japanese application the word 'nitric' [in Japan se, presumably] is used at each place where the word 'nitrous' appears in the U.S. application and that the error was due to faulty translation of the Japanese into English. Beside that, all of the circumstances of the case as shown by correspondence introduced with the affidavit of Arnold G. Gulko, the U.S. attorney, point to the existence of a translation error which was discovered by the inventors during the prosecution. The Patent Office complains that there is no certified copy of the Japanese application on file and no sworn translation. While no doubt the best evidence of translation error would be, in part, a copy of the Japanese application or patent, its absence is not fatal since we find the evidence of record sufficient. There is not the slightest evidence to cast doubt on appellants' assertions or any suggestion they are trying to change the nature of the invention patented." [Emphasis supplied] [Page 272]

Please note that applicant has submitted a copy of the priority Swiss application and that the declaration of the translator who made the translation error has been filed.

Respectfully submitted,

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